



503.35255V14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): K. AOTA, et al.

Appln. No. 10/600,572

Filed: June 23, 2003

For: FRICTION STIR WELDING METHOD OF OPPOSITE SIDES OF
PANELS

Group: 3635

Examiner: B. Katcheves

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 20, 2004

Sir:

In response to the Office Action mailed April 20, 2004, Applicants respectfully submit the enclosed Terminal Disclaimer, for overcoming the sole rejection of claims in the above-identified application, that is, the rejection of claims 1-8 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-4 of U.S. Patent No. 6,619,534.

In this regard, it is respectfully submitted that the enclosed Terminal Disclaimer satisfies all applicable requirements of 37 CFR 1.321(b) and (c), such that the enclosed Terminal Disclaimer clearly overcomes the obviousness-type double patenting rejection. In view of the submission of the enclosed Terminal Disclaimer, the obviousness-type double patenting rejection on pages 2 and 3 of the Office Action mailed April 20, 2004, is moot.

The enclosed Terminal Disclaimer is being submitted presently so as to clearly overcome the obviousness-type double patenting rejection and achieve earliest possible issuance of a U.S. patent from the above-identified application. It is respectfully submitted that the present submission of the enclosed Terminal Disclaimer does not constitute agreement with, or an admission as to the propriety of, the obviousness-type double patenting rejection; and does not constitute agreement with, or an admission as to the propriety of, arguments made by the Examiner in connection with the obviousness-type double patenting rejection.

The refusal by the Examiner to consider the documents listed on page 2 of the Form PTO/SB/08A enclosed with the Information Disclosure Statement filed June 23, 2003, in the above-identified application, is respectfully traversed. Basis for refusal to consider the documents listed on this page 2 is the requirement by the Examiner of a legible copy of each U.S. and foreign patent, and each publication or that portion which caused it to be listed, and all other information for that portion which caused it to be listed. However, the Examiner's attention is respectfully directed to 37 CFR 1.98(d), which states, in pertinent part, that:

(d) a copy of any patent, publication, ... listed in an information disclosure statement is required to be provided, even if the patent, publication ... or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

It is respectfully submitted that the Information Disclosure Statement submitted June 23, 2003, in the above-identified application, identifies a prior application of the above-identified application, Application No. 08/820,231, in which the documents listed on this page 2 of 2 were submitted. As can be seen from the documents listed on the printed U.S. Patent No. 6,581,819, which issued from Application No. 08/820,231, all of the listed documents on page 2 of 2, except for "Verksstadnerna Nr 2, pp. 32 and 34 (1996)", are listed on the printed U.S. Patent No. 6,581,819. It is respectfully submitted that all of the documents listed on page 2 of 2 of the Form PTO/SB/08A enclosed with the Information Disclosure Statement submitted June 23, 2003, except for Verksstadnerna Nr 2, pp. 32 and 34 (1996) satisfy 37 CFR 1.98(d)(1) and (2), such that copies of these documents need not have been submitted.

In view of the foregoing, reconsideration by the Examiner, and consideration of at least all documents on page 2 of 2 of the Form PTO/SB/08A enclosed with the Information Disclosure Statement submitted June 23, 2003, with the exception of Verksstadnerna Nr 2, pp. 32 and 34 (1996), upon further examination of the above-identified application, are respectfully requested.

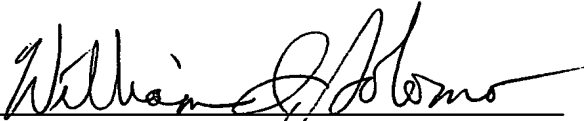
To facilitate consideration by the Examiner, enclosed herewith is another copy of page 2 of 2 of the Form PTO/SB/08A that was submitted with the Information Disclosure Statement filed June 23, 2003, for the Examiner to initial with respect to documents being considered thereon.

In view of all of the foregoing, entry of the enclosed Terminal Disclaimer, and reconsideration and allowance of all claims presently in the application, in light of indicated consideration of additional documents in view of the foregoing, are respectfully requested.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 503.35255V14), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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